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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/134,831	08/17/1998	RICHARD P. METTKE	6388.005	8517

7590 02/23/2007  
Richard Mettke  
7921 Panary Court  
Reynoldsburg, OH 43068

EXAMINER
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WOO, STELLA L

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	.02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/134,831

Applicant(s)

METTKE, RICHARD P.

Examiner

Stella L. Woo

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 27, 2006 has been entered.

### ***Drawings***

2. The drawings are objected to because the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of drawing during the prosecution of the original patent for the same reasons given in the final Office action mailed March 12, 2002. 37 CFR 1.121 (a)(6) state that no amendment may introduce new matter into the disclosure of an application. Figure 2, as originally filed, shows a cubicle with a work area/desk top, privacy wall, chair/stool and a terminal device generally labeled as numeral 2. There is no support in the original disclosure for the terminal housing as incorporating the

monitor, keyboard, and credit card reader in the manner depicted in the current Figure 2. Correction is required.

***Specification***

3. As previously addressed in the final Office action mailed March 12, 2002, new matter was added as an amendment to the specification during the prosecution of the original patent. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: col. 2, lines 3-7; col. 2, line 53 – col. 3, line 3.

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the article by Allen Weiner, entitled "TouchFax Provides the Ultimate in Place-Based Interactivity" (submitted as Exhibit E in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit E") in view of the TouchFax brochure

entitled "Vision, Power, Versatility" (submitted as Exhibit F in the TouchNet Protest on November 4, 1998, hereinafter "Exhibit F"), and further in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web", submitted with the Protest by North Communications, Inc. as Exhibit I (hereinafter "the Shah article") for essentially the same reasons given in the final Office action mailed March 12, 2002 and the Examiner's Answer mailed August 17, 2005, and affirmed by the BPAI Decision mailed August 31, 2006. Therefore, claim 6 is rejected on the ground of *res judicata* (see MPEP 706.03(w)).

Exhibit E discloses a public on-line terminal (TouchFax public terminal; Exhibit E, first page, fifth paragraph) comprising:

a central processing unit (386 microprocessor; Exhibit E, second page, first column, third paragraph, line 3);

a video display monitor (touch-sensitive color video monitor; Exhibit E, second page, first column, first paragraph and lines 2-3 of the third paragraph);

a keyboard (full-size keyboard; Exhibit E, second page, first column, third paragraph, lines 4-5);

a credit card reader (Exhibit E, second page, first column, second paragraph, lines 4-6);

means for accessing and allow for user interaction (via touchscreen and computer modem; Exhibit E, second page, second column, second paragraph);

a printer (high-volume laser printer; Exhibit E, second page, first column, third paragraph, line 4).

Exhibit E differs from claim 6 in that it does not *explicitly* recite software installed into the CPU to allow interaction with credit card centers. However, Exhibit F teaches the use of such software installed into the CPU of a TouchFax terminal to carry out its communications functions (Exhibit F, first page, second paragraph) such that it would have been obvious to an artisan of ordinary skill to use such installed software, as described in Exhibit F within the TouchFax terminal of Exhibit E to carry out its communications functions with the credit card centers in order to authorize payments made via the credit card reader.

The combination of Exhibits E and F differs from claim 6 in that it does not specify accessing and interfacing with the Internet. However, the combination does allow for accessing and interfacing with a remote service provider via a modem and the Shah article teaches the desirability of providing access to and interaction with the Internet in a kiosk-based information system (pages 1-2, section entitled "The Effectiveness of the World Wide Web as Kiosk-based Information System") via the use of appropriate software (Web browser; page 2, section entitled "The Access Interface," line 2) to provide users with access to the many services on the Internet including a paid service by commercial organizations which charges customers for access to specific services (page 2, section entitled "Who will use these systems?" and page 5,

lines 11-12). It would have been obvious to an artisan of ordinary skill to incorporate such means for accessing and software for interfacing with the Internet in a kiosk information system, as taught by the Shah article, within the combination of Exhibits E and F in order to provide users with access to the many services available on the Internet.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Exhibit C (including Exhibits C, 1 to C, 6), Exhibit D, Exhibit E, Exhibit F, L&G ISDN console, Internet Navigator, Aliens, and On Haiti, for the reasons given in the BPAI Decision mailed August 31, 2006 (see Decision, pages 42-58).

#### ***Response to Arguments***

7. Applicant's arguments filed October 25, 2006 have been fully considered but they are not persuasive.

Applicant argues that "Shah teaches away from accessing the Internet." The examiner disagrees. Firstly, the title of the Shah article is "Suggestions for Information Kiosk Systems using the World Wide Web." On page 2, line 4, Shah clearly states that "the Web is part of the Internet. This allows users access to the many services on the Internet." Moreover, in the BPAI decision, which is in effect, the "law of the case" (see MPEP 706.03(w)), the Board states that "Shah teaches, in 1994, providing Internet access from a public kiosk in order to give users access to the many services on the Internet. Shah suggests that consumers wanted access to the Internet for these services. One of ordinary skill in the art would have been motivated to provide Internet access

as an additional pay-for-use service in the public kiosks of Exhibit E and F to achieve this advantage and consumer demand.” (see BPAI Decision, page 31, lines 3-9).

Applicant argues that the “TOUCHFAX AMERICA” videotape is not permitted in prior art. The examiner disagrees. Exhibit C is a videotape recorded May 14, 1993, and distributed by TouchFax Information Services as advertising at the May 1993 Comdex trade show in Atlanta, Georgia. The videotape advertises the use of the TouchFax kiosks for a variety of purposes including pay-per-user access to the Prodigy online computer service provider and for connection to the Internet. According to 35 USC 102(b), prior art is defined as evidence that “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” The publicly distributed, advertising videotape of TouchFax can be considered as a “printed publication.” As noted in the BPAI Decision (page 15, lines 3-8), “‘Printed publication’ is now addressed as a unitary concept where ‘the question to be examined under 102(b) is the accessibility to at least the pertinent party of the public, of a perceptible description of the invention, in whatever form it may have been recorded.’” Moreover, the BPAI Decision clearly states that “all references are prior art ‘printed publications.’” TouchFax Exhibit C through Exhibit F were publicly distributed as discussed



in the deposition of Daniel Toughey, President of TouchFax” (Decision, page 41, last paragraph).

Applicant further argues that the “only suggestion would be if they (Touchfax) saw the applicant’s disclosure and added this capability to their terminal.” However, the test for obviousness is what the combined teaches of the references would have suggested to those of ordinary skill in the art at the time the invention was made, which is the filing date of the present invention, i.e. January 25, 1995. Numerous prior art references were relied upon by both the examiner and the BPAI which show the teaching of Internet access at a public terminal prior to the applicant’s filing date of January 25, 1995.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The BPAI has clearly described the motivation found in the references themselves or in the knowledge generally available to one of ordinary skill in the art (see Decision, pages 56-58).

**Conclusion**

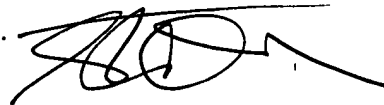
8. This is an continued examination of applicant's earlier Application No. 09/134,831. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Stella L. Woo  
Primary Examiner  
Art Unit 2614